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PATENT TRADEMARK OFFICE

Docket No.: 2875/1G342US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Samuel Sergio TENENBAUM

Serial No: 09/922,232

Group Art Unit: 3622

Confirmation No.: 7566

Filed: August 3, 2001

Examiner: Stephen Gravini

For: COMPUTERIZED ADVERTISING METHOD AND SYSTEM

DECLARATION OF BRAD MYERS

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

I, Brad Myers of 400 South Homewood Avenue, Pittsburgh, PA 15208,

declare:

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1. I am on the faculty in the Human-Computer Interaction Institute, School of Computer Science, Carnegie Mellon University, Pittsburgh PA 15213. I received my Ph. D. in Computer Science from the University of Toronto in 1987. I am listed in *Marquis Who's Who in Science and Engineering* for 1998-2001, and I am included in *Outstanding Scientists of the 20th Century*. I have taught computer science courses to both undergraduate and graduate students for 14 years. Based on this experience, I am familiar with the level of technical skill of computer science students.

2. I have reviewed the specification of United States Patent Application No. 09/922,232. I have reviewed the final office action of Examiner Stephen Gravini dated December 19, 2002. I have further reviewed the prior art references relied on by the examiner in the final office action, as well as his affidavit incorporated in it.

3. It is my understanding that, in Paragraph 1 at Page 2 of the final office action, the examiner rejects Claims 1-52 and 58-62 as containing subject matter which was not described in the technical description of the patent application in such a way as to reasonably convey to a person skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The examiner specifically refers to the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient, and message. In my opinion, the examiner is incorrect about this.

a. Starting at page 4, Line 24, the present application explains how an animated character is created. For this purpose, use is made of

the "Flash" program by Macromedia, which is a well-known program, commercially available since 1997, used to create multimedia content for introduction into internet web pages. It is explained there that the animation character is inserted as a Flash object on the top layer of the display of the browser window by means of a public domain, JavaScript script. The script is described as being capable of placing the object anywhere on the screen of the browser. Since the object is in the top layer of the display, it is unscrollable and out of the user's control. It is also described that another JavaScript script communicates with the Flash object to time its execution, again, placing the Flash object out of the user's control and making it unpredictable to the user.

- b. If multiple versions of animated characters were available, having the program select a character, greeting, recipient or message would be commonplace and presents no technical challenge.
- c. An undergraduate student in computer science could easily learn how to use the Flash program and would then be able to accomplish the results described in the application. Numerous JavaScript scripts are available in the public domain for many purposes, including examples like those described above. Writing

a simple JavaScript script to time the execution of a Flash object would be well within the skill of an undergraduate computer science student.

4. The examiner also rejected Claims, 7, 10, 19, 20, 29, 32, 38, 41, 46, 51 and 62 as “non-enabling,” (I understand “enabling” to mean that a technical person of ordinary skill would learn how to make and use the invention from the description) because, according to the examiner, the application disclosure would not allow a person skilled in the art of computer display to:

- a. Define a plurality of characters which are selected and controlled according to information from the user’s computer which is not under the user’s control and technical features available in the user’s computer; or
- b. Create an HTML page to be received by a user from a content provider’s server and to have the multimedia character introduced in it as a result of tags left in the page.

5. Again, It is my opinion that the examiner is wrong. In Paragraph 3 above, it was explained how the application describes that a multimedia character may be introduced. There would be no technical challenge to having more than one character, or to have the character selected and controlled

according to information in the user's computer which is not under the user's control. As for selecting or controlling characters according to technical features available in the user's computer, the last paragraph on Page 4 of the application and the first paragraph at Page 5 of the application describe alternate ways of creating and controlling the animated character, based upon what technologies are available in the computer. Furthermore, the paragraph starting at Page 5, Line 11, specifically explains that an HTML page will use the technology that is available. Thus, it is my opinion that an undergraduate student in the field of computer science could easily realize the features discussed in Paragraph 4a above, based upon the disclosure of the present patent application.

6. It is also my opinion that the examiner is wrong about the features discussed in Paragraph 4b above. The use of the tags in a HTML page to achieve transfer to or acquisition of information from an external source is well-known in this art. The examiner seems to be familiar with this technology, since he reflects an understanding in the last 5 lines of the first page of his affidavit that tags have been used in this manner for many years. To that extent, it appears to me that the examiner has taken inconsistent positions between his rejection and his affidavit. An undergraduate student would be well aware of how to use this "tag" technique, simply from its discussion, and would not require any specific teachings about the technique.

7. I note that at Page 3, starting at Line 2 of the office action, the examiner refers to the feature "completely beyond the user's control" as a basis

for the claim being indefinite. The examiner states that this is indefinite because a user always has control of a computer. I believe that anyone of ordinary skill in computer science, including an undergraduate student, would understand that "completely beyond the user's control" refers to "said character" and not the computer. Specifically, those skilled in the art would realize that the character is intended to be beyond the user's control while the application program is running, as is clear from the claim. Interpreting this to mean that the computer must be beyond the user's control would be nonsensical, not to mention technically impossible, since the user can always turn off the computer or disconnect it from the power source, as noted by the examiner.

8. The office action indicates in Paragraph 3 at Page 4 that Claims 1-52 and 58-62 are rejected as "anticipated" by several references under "35 U.S.C. 102(b)" and over several other references under "35 U.S.C. 102(e)." I have been instructed by counsel for the applicant that the effective filing date for the present patent application predates all references cited under 35 U.S.C. 102(e) except Wexler et al. U.S. Patent No. 5,960,409. I have therefore only considered that patent and the patents cited with respect to 35 U.S.C. 102(a) (U.S. Patents to Petrecca et al., Reilly et al., Albert and Schena et al.). It is my understanding that for an anticipation rejection to be proper, every feature of the claim must be present in a single reference. My review of the references indicates that none of the references includes every feature of any claim in this application.

9. I consider a number of aspects of the invention as presented in independent claims (I understand "independent claims" to be those that do not refer back to another claim) to be unique. First of all, the character appears on the application program's screen display or window in a way that prevents the user from controlling it (preferably on top of the normal content). Second, the character appears intrusively in a manner which is unpredictable for the user. Third, the character is completely beyond the user's control.

10. The patents to Petrecca, Rielly and Shena do relate to advertising systems on computers or networks, but they bear no relationship to introducing a character on the window of an application program with any of the features described above.

11. The cited patent to Cohen relates to a standalone promotional game, method and apparatus, similar to a slot machine. However, it bears no relationship to introducing a character in the display of an application program operating on a user's computer, and it does not have the slightest relationship to achieving a character with any of the distinctive features described above.

12. The cited patent to Wexler discloses a system which uses banners, which I find presented in the present patent application as being undesirable. Interestingly, Wexler also makes use of tags, which the examiner believed were not sufficiently disclosed in the present patent application. However, the animated character of the present patent application is and is intended to be entirely different from banners, since it appears unpredictably and, unlike

banners, is out of the user's control. The cited Albert patent, like Wexler, relates to banner advertising and, for the same reason, does not disclose any of the unique features of the present invention. I must totally disagree with the examiner that either of these references could possibly anticipate the presently claimed invention.

13. At Page 5 of the office action, the examiner rejected all of the claims in this application as being an obvious variation of the Juno Online Services method of multimedia advertising, presented from the examiner's personal knowledge related thereto, as set forth in his affidavit. I am familiar with the type of advertising that the examiner identifies as "pop-up advertisement." When such advertisement is presented to a user observing the display of an internet page, the pop-up advertisement does not appear in the display of the page or the application program (i.e. the browser) that the user is observing, but it in fact appears in a separate window. Such windows are not out of the user's control, but can easily be closed or moved. This is in stark contrast to the multimedia character of the invention which is in the same window as the internet page (i.e. in the browser's own window), and is out of the user's control. Since pop-up advertisements are actually in a separate window, they remain on the user's display if they are not closed. Should the user close the browser window, he then needs to close each pop-up advertisement separately.

14. In summary, the Juno pop-up advertisement does not meet the claimed description of the present invention, because it is not out of the user's

control and because it does not appear in the application program's screen display or window.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further, that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or punishment, or both, under Section 1001 of Title 18 of the United States Code.

Date:

April 28, 2003


Brad Myers